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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICH ROGERS and DAVID VANTREASE

Appeal 2008-3339
Application 09/727,972¹
Technology Center 2600

Decided:² March 13, 2009

Before JOSEPH L. DIXON, JEAN R. HOMERE, and JAY P. LUCAS,
Administrative Patent Judges.

LUCAS, *Administrative Patent Judge.*

DECISION ON APPEAL

¹ Application filed November 30, 2000. Real party in interest is Hewlett Packard Development Company, L.P., successor in interest to Compaq Computer Corporation.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Appellants appeal from a final rejection of claims 1 through 32 under authority of 35 U.S.C. § 134. The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

Appellants' invention relates to a method and system for selecting icons to appear on a small electronic screen on a keyboard, the icons appearing above respective launch buttons for programs or web pages. In the words of the Appellants:

A method and apparatus for displaying icons on a user-configurable keyboard. Specifically, icons corresponding to software applications or uniform resource locators (URLs) are selected from a computer system monitor. The icons are transmitted to the key board and displayed in a display window, such as a liquid crystal display (LCD). Each icon displayed in the LCD on the keyboard has a corresponding launch key. When a launch key is depressed, the application or URL corresponding to that launch key will be opened.

(Spec. 24, Abstract).

Claim 1 and claim 15 are exemplary:

1. A user-configurable keyboard comprising:
a display configurable to display a plurality of icons; and
a plurality of keys corresponding to the plurality of icons and configurable to launch one of a software program and a Uniform Resource Locator [*sic*] corresponding to a respective icon.

15. A method of configuring a keyboard comprising the acts of:
- (a) selecting an icon from a system monitor, the icon corresponding to one of a software application and a uniform resource locator;
 - (b) transmitting the icon from the monitor to a keyboard; and
 - (c) displaying the icon on the keyboard.

PRIOR ART

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Kim	5,181,029	Jan. 19, 1993
Rosenberg	6,693,626 B1	Feb. 17, 2004

REJECTIONS

The Examiner rejects the claims as follows:

R1: Claims 1 to 3, and 5 stand rejected under 35 U.S.C. § 102(b) for being anticipated by Kim.

R2: Claim 4 stands rejected under 35 U.S.C. 103(a) for being obvious over Kim.

R3: Claims 6 to 32 stand rejected under 35 U.S.C. 103(a) for being obvious over Rosenberg in view of Kim.

Groups of Claims:

Claims will be discussed in the order of the Appellants' arguments.

Appellants contend that the claimed subject matter is not anticipated by Kim, or rendered obvious by Kim alone, or in combination with Rosenberg, for failure of the references to teach or suggest important claim limitations. The Examiner contends that each of the three groups of claims is properly rejected.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this opinion. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived.

We affirm the rejections.

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a). The issue turns on whether Kim teaches a keyboard comprising a display, and whether the references jointly teach transmitting an icon from a monitor to a keyboard.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellants have invented a keyboard, and a computer system incorporating the keyboard, in which the keyboard includes a display screen capable of displaying icons above a series of launch buttons or

keys. (Spec. 12, bottom; Fig. 3). The system permits a user to select icons on a computer monitor to be assigned to, and appear on the keyboard display screen above, the respective launch keys that activate a program or web address (URL). (Fig. 5; Spec. 15, top).

2. The reference Kim teaches a keyboard for a computer, on which can be overlaid an electronic template with holes to surround and fit over various function keys that are commonly placed on a standard keyboard. (Col. 3, ll. 22-40). Also on the template is a liquid crystal display (LCD) screen above the function keys, divided into areas directly above each function key. (Col. 3, l. 47). Icons can be displayed in the area above each function key, indicative of a program activated by that function key. (Col. 3, l. 59; Col. 4, l. 1). Template driver software receives data from an associated computer indicating the icon to be displayed above each key. (Col. 6, ll. 9-24).
3. The reference Rosenberg teaches a *haptic* keyboard (i.e. a keyboard with tactile feedback) attached to a computer system including a monitor, a CPU, an operating system and a Graphical User Interface including icons. (Col. 5, ll. 29-35). The keyboard is pictured with the standard function keys in Figure 1.

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

Our reviewing court states in *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) that "claims must be interpreted as broadly as their terms reasonably allow."

"It is common sense . . . that familiar items may have obvious uses beyond their primary purposes, and . . . a person of ordinary skill often will be able to fit the teachings of multiple patents together like pieces of a puzzle." *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007).

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted).

ANALYSIS

From our review of the administrative record, we find that the Examiner has presented a *prima facie* case for the rejections of Appellants' claims under 35 U.S.C. §§ 102 and 103. The *prima facie* case is presented

on pages 3 to 13 of the Examiner's Answer. In opposition, Appellants present a number of arguments.

*Arguments with respect to the rejection
of claims 1 to 3 and 5
under 35 U.S.C. § 102(b) [R1] and
claim 4
under 35 U.S.C. § 103(a)[R2]*

Appellants contend that the Examiner erred in rejecting claims 1 to 3, and 5 under 35 U.S.C. § 102(b) because “in sharp contrast to the claimed invention, the LCD screen of Kim is clearly *not* part of the keyboard. Instead, the LCD screen 70 is provided on an electronic keyboard template 10, which is merely overlaid onto a computer keyboard 20.” (App. Br. 7, bottom).

During prosecution before the Office, claim limitations are interpreted broadly. “Claims must be interpreted as broadly as their terms reasonably allow.” *In re Zletz*, 893 F.2d at 321 (cited above).

Appellants' argument that the display in Kim is somehow not physically a part of the keyboard, or integral to it, or connected to it, is based on limitations that are not found in independent claim 1. The claim merely uses the common phrase “[a] . . . keyboard comprising: a display” In Kim the display is electrically connected to the keyboard (*see* Figure 2) and depends on unknown forces (perhaps gravity) to keep it in place. But the mode of adhesion is not at point, as it is not claimed. The term “comprising” merely means the following elements are part of what the Appellants call their keyboard, and in this case a display is part of the elements combining to make the keyboard. *See Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376

(Fed. Cir. 2004) for a discussion of “comprising” and “containing”, both of which are open-ended. Kim shows a keyboard which includes the display as an element thereof. We conclude that the presence or absence of a permanent means of affixing or incorporating the display into the keyboard body is irrelevant to the instant claimed invention, and decline to find error in the Examiner’s rejection under 35 U.S.C. § 102(b).

As the same grounds for objection are proffered by Appellants with regard to the rejection of claim 4 under 35 U.S.C. § 103(a) over Kim, we will extend the same response, and decline to find error in [R2]. (App. Br. 10, top). Additionally we note that display #70 in Kim is described as a single display with various areas, each related to a function key #50, similar to the structure in the claim. (Col. 3, l. 47). (See App. Br. 17, top).

*Arguments with respect to the rejection
of claims 6 to 32
under 35 U.S.C. § 103(a)[R3]*

The Examiner has rejected claims 6 to 32 for being obvious over the combination of Rosenberg in view of Kim. In general terms, Rosenberg teaches a computer system with a keyboard containing function keys, to which teaching the Examiner adds that of the display keyboard of Kim. (See FF #2, #3 above; Answer 5-13).

Appellants first argue that Kim fails to teach a keyboard comprising, *inter alia*, a display. (App. Br. 11, middle). We have declined to find error in Examiner’s reasoning on that point. (See above.)

Appellants further argue with respect to independent claims 15 and 23 that the references fail to teach or suggest “selecting an icon from a system monitor . . . transmitting the icon from the monitor to a keyboard [and] displaying the icon on the keyboard.” (App. Br. 12, middle).

This is admittedly a troublesome limitation to claims 15 and 23, because if taken literally it states that an image, the icon, is transmitted from the monitor through the air or wires to the keyboard, where it is shown on a display on the keyboard. We know that the Appellants do not mean it that way, as they show in Figure 2, and describe in the Specification that data to be displayed on the monitor comes from display driver #48, in a conventional manner. (Spec. 10, bottom). Reading the Specification as a whole, we are brought to understand that the selected icon displayed on the monitor #14 is then regenerated for display on the keyboard display. It is only “conceptually” transmitted to the keyboard from the monitor, and we will interpret the claim in that fashion, speculative though it may be.

The Examiner describes the keyboard in Rosenberg being connected by a bidirectional bus to a computer system, including a processor, keyboard, and a monitor. (Answer 15, bottom). Kim teaches a computer system, including a monitor, attached to his special display keyboard, wherein the computer sends a selected image from the host computer #120 to RAM #155 and hence to LCD screen #70 on the keyboard. (Kim, col. 6, ll. 9-26). The image of the icon on the computer would appear to be conceptually transmitted to the keyboard. We thus agree with the Examiner that the combined teachings of the two references support the rejection of the claims under 35 U.S.C. § 103.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1 to 32 under 35 U.S.C. § 102 and 35 U.S.C. § 103 respectively.

DECISION

The Examiner's rejections of claims 1 to 32 (R1, R2 and R3) are Affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

msc

INTELLECTUAL PROPERTY ADMINISTRATION
LEGAL DEPARTMENT M/S 35
PO BOX 272400
FT. COLLINS CO 80527-2400